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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,125	01/03/2004	Linggawati Tanamal	4001-0007 (ZM0515)	1756

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EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicant(s) 10/751,125	Applicant(s) TANAMAL ET AL.	
	Examiner David Comstock	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15 and 16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12, 15 and 16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 03 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-5, 8-12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmy (5,722,977; cited by Applicant).

Wilhelmy discloses an osteotome 7 comprising a head portion 36 including a first planar surface 37 and a second planar surface, e.g. 39, extending therefrom (see Fig. 7). A bone cutter 38 defines a single contiguous sharp edge and extends perpendicularly from the first planar surface along the cutting edge of the second planar surface. An anvil 44 is included in the head portion. An elongated rod portion 48 extends away from the first and second surfaces and includes a graspable extent, i.e. a handle. An anvil 49 is coupled to the handle. A third planar surface 43 extends from the second planar surface. The surfaces extend from each other at about 95 degrees, i.e. 90 degrees is considered to be within the indeterminate range "about 95 degrees." The surfaces appear to be smooth. Wilhelmy does not disclose the obtuse angles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device with obtuse angles or angles of about 135 degrees (for example to provide a trapezoidal cross-section to accommodate individual patient

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anatomy), or to form them to be any of numerous other angles that connect the four surfaces, since it has been held that where the general conditions of a claim are disclosed in the prior art, i.e. an osteotome having surfaces separated by some given angle, discovering the optimum or workable ranges of the same involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmy (5,722,977; cited by Applicant) as applied to claim 5 above, and further in view of Urbahns et al. (6,264,657; cited by Applicant).

Wilhelmy, as modified, discloses the claimed invention except for the protuberance on the surface. Urbahns et al. disclose an osteotome 10 comprising a protrusion centered at the end of the surface to provide additional strength and rigidity to the device (see Figure A, below). It would have been obvious to provide a centered protrusion on the osteotome of Wilhelmy, as modified, in view of Urbahns et al., in order to provide additional strength to the surfaces and increase the rigidity of the device.

Protrusion reinforcing the blade

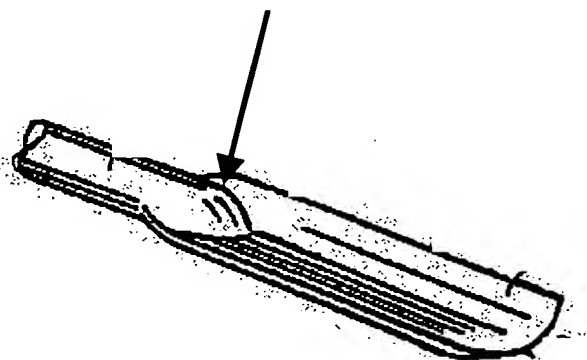


Figure A

***Respons to Arguments***

Applicant's arguments filed 29 October 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that Wilhelmy does not anticipate or render obvious applicant's invention because it teaches away from an osteotome having less than four sides, the following is noted. Examiner neither makes this argument, nor is such an argument necessary for the rejection. As set forth and exemplified in the rejection, two of the angles could be provided at an angle of about 135 degrees, resulting in a trapezoidal cross-section, which has four sides (see Non-Final Rejection, page 4, lines 1-8). Furthermore, as previously discussed, discovering the optimum or workable ranges of angles or dimensions of the device involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

In response to applicant's argument that the combination of Wilhelmy and Urbahns et al. does not render Applicant's invention obvious, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, the combined teachings suggested providing a protrusion on a bone-cutting blade to reinforce the blade. A person of ordinary skill in the art can readily appreciate the need for a strong surgical tool that does not buckle or break in use. That the distal ends of the blades of

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the device of Wilhelmy are sharp does not show that the proximal ends cannot be reinforced for more strength and reliability. Furthermore, as shown by Urbans et al., the protrusion would be on the top, i.e. the outside, of the device of Wilhelmy et al. Therefore, the protrusion would be at the opposite end from the cutting edge and on the outside or top of the device, and not within the bone plug region.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well within the knowledge generally available to a person of ordinary skill in the art that a reinforced surgical tool that does not buckle or break in use would be desirable.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
5 January 2005



Todd E. Manahan  
Primary Examiner